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## TRANSMITTAL LETTER

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

RE: Attorney Docket No.: PIP-69A-KATZ  
Application Serial No.: 09/776,714  
Filed: 02/06/01  
Title: Method and System for Timing Promotions Based on Prior Receipt  
of Promotions  
Inventor: GARY M. KATZ  
Group Art Unit: 3622  
Examiner: Raquel Alvarez

SIR:

Attached hereto for filing are the following papers:

37 CFR 1.181 Petition to Reinstate Withdrawn Claims 59-61 and Have the Withdrawn Claims  
Examined on Their Merits

Our check in the amount of \$130.00 is attached covering the required fees.


The Commissioner is hereby authorized to charge any fees which may be required, or  
credit any overpayment, to Deposit Account Number 50-2106.

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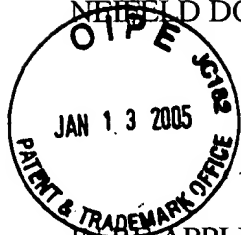
PATENT TRADEMARK OFFICE

1/12/2005  
Date

  
Richard A. Neifeld, Ph.D.  
Registration No. 35,299  
Attorney of Record

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Printed: January 12, 2005 (4:31pm)

NEELED DOCKET NO: PIP-69A-KATZ



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: Gary M. KATZ

USPTO CONFIRMATION CODE: 2896

SERIAL NO: 09/776,714

FILED: February 6, 2001

EXAMINER: ALVAREZ

GROUP ART UNIT: 3622

FOR: Method and System for Timing Promotions Based on a Prior Receipt of Promotions

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 1.181 PETITION TO REINSTATE WITHDRAWN CLAIMS 59-61 AND  
HAVE THE WITHDRAWN CLAIMS EXAMINED ON THEIR MERITS

Sir: Please grant this petition. .

**I. STATEMENT OF THE PRECISE RELIEF REQUESTED**

The applicant requests that the Director instruct the examiner to reinstate withdrawn claims 59-61 and examine those claims on the merits, and issue a non-final office action examining inter alia claims 59-61.

## II. STATEMENT OF MATERIAL FACTS

### 1. Method Claims 1 and 59 read as follows:

Claim 1 (Original): A computer-implemented method comprising steps of:  
receiving identification information from a consumer;  
identifying, based upon said received identification information, one or more parameters related to promotions received by said consumer; and  
determining a time at which a promotion is to be provided based upon said identified one or more parameters related to promotions received by said consumer.

Claim 59 (New): A computer-implemented method, comprising:  
receiving identification information from a consumer at a vendor location site, comprising a vendor terminal, wherein said vendor terminal is located at a check-out counter in a store;  
identifying, based upon said received identification information, one or more parameters related to promotions received by said consumer; and  
determining a time at which a promotion is to be provided based upon said identified one or more parameters related to promotions received by said consumer.

2. The difference between claims 1 and 59 is that claim 59 recites that the identification information is received from the consumer "a vendor location site, comprising a vendor terminal, wherein said vendor terminal is located at a check-out counter in a store."

### 3. System claims 28 and 60 read as follows:

Claim 28 (Original): A system, comprising:

means for receiving identification information from a consumer;  
means for identifying one or more parameters related to promotions received by said consumer based upon said identification information received by said means for receiving; and  
means for determining a time at which a promotion is to be provided based upon said one or more parameters related to promotions received by said consumer, said one or more parameters identified by said means for identifying.

Claim 60 (New): A system, comprising:

means for receiving identification information from a consumer at a vendor location site, which comprises a vendor terminal, wherein said vendor terminal is located at a check-out counter in a store;  
means for identifying one or more parameters related to promotions received by said consumer based upon said identification information received by said means for receiving; and  
means for determining a time at which a promotion is to be provided based upon said one or more parameters related to promotions received by said consumer, said one or more parameters identified by said means for identifying.

4. The difference between claims 28 and 60 is that claim 60 recites that the information is received from the consumer "at a vendor location site, which comprises a vendor terminal, wherein said vendor terminal is located at a check-out counter in a store."

5. Claim 61 reads as follows:

Claim 61 (New): A system, comprising:

a consumer identification information receiver at a vendor location site configured to receive consumer identification information from a consumer, wherein said vendor location site is a check-out counter in a store;

a consumer identification record configured to contain stored consumer identification information of said consumer;  
a consumer characteristic record configured to contain a record of characteristics of said consumer;  
a promotion output device configured to output a targeted promotion at a promotion time based at least in part upon said record of characteristics of said consumer; and  
a processor configured to use said received consumer identification information to identify a consumer record using said stored consumer identification information, and to determine said promotion time at least in part based upon said record of characteristics of said consumer contained in said consumer characteristic record.

6. In a final office action mailed 1/7/2005, page 2 lines 7-14, the examiner states that:

Newly submitted claims 59-61 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: recite a vendor location site and a checkout counter located at the vendor location site.

Since the application has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 59-61 are withdrawn from consideration as being directed to a non-elected invention. see 37 CFR 1.142 and MPEP 821.03.

7. This application is under final rejection.

8. Reconsideration of the restriction of claims 59-61 was requested in a paper filed 1/12/2005.

### III. REASONS WHY THE RELIEF REQUESTED SHOULD BE GRANTED

This application is already under final rejection, the withdrawal of claims 59-61 is therefore final. Accordingly, the requirement in 37CFR 1.144 to request reconsideration of the withdrawal is inapplicable. Moreover, reconsideration was requested in the paper filed 1/12/2005, one day prior to the filing of this petition. Hence, this petition is proper.

The examiner's withdrawal of claims 59-61 was improper because the examiner failed to make the showings required to support a restriction requirement. Therefore, claims 59-61 should be reinstated. Since these claims have not been examined, the examiner should issue a new office action superceding the existing office action in which claims 59-61 are examined.

The only statement provided by the examiner why she withdrew claims 59-61 is "recite a vendor location site and a checkout counter located at the vendor location site." That statement does not support a conclusion that claims 59-61 define subject matter independent or distinct from the pending examined claims. The examiner is required to both identify the basis for a restriction requirement and explain why restriction is proper, based upon the criteria specified in the MPEP.

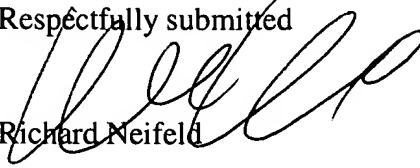
The examiner failed to specify any reason why claims 59-61 define subject matter independent and distinct from the pending claims, which is a requirement for a proper restriction requirement.

The examiner also failed to identify any serious burden in examining claims 59-61, which is also a requirement for a proper restriction requirement.

It is unlikely that the examiner can show a proper basis for restricting claims 59-61. Claims 59 and 60 are each within the scope of claims 1 and 28 respectively, adding the limitation that the identification information is received from the consumer "a vendor location site, comprising a vendor terminal, wherein said vendor terminal is located at a check-out counter in a store." I think it doubtful that the examiner can show why claims narrower in scope than the pending examined claims are independent or distinct. Claim 61 is similar to claim 60. I think it doubtful that the examiner can show why a legitimate basis to restrict claim 61 in view of claims 28 and 60.

In any case, the examiner's withdrawal of claims 59-61 is improper. Therefore, this petition should be granted.

Respectfully submitted

A handwritten signature in black ink, appearing to read 'Richard Neifeld', written over the typed name.

Richard Neifeld

Registration No. 35, 299

Attorney of Record

Date/time: January 12, 2005 (12:54pm)

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